



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/585,784

08/17/2007

Paivi Maatta

0696-0244PUS1

1424

2292 7590 11/16/2010
BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

GOFF II, JOHN L

ART UNIT

PAPER NUMBER

1746

NOTIFICATION DATE

DELIVERY MODE

11/16/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary	Application No. 10/585,784	Applicant(s) MAATTA ET AL.	
	Examiner John L. Goff	Art Unit 1746	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) 1-5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 July 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>7/11/06, 3/4/10</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group 2, claims 6-8, in the reply filed on 9/13/10 is acknowledged. The traversal is on the ground(s) that (1) there are related technical features between the two groups of claims and (2) there would be no undue burden on the Examiner to examine both groups of claims. This is not found persuasive because the Groups were shown to lack unity of invention in paragraph 2 of the restriction requirement. As to examination and search burden, the instant application is a 371 application and restrictable under PCT rules wherein a showing of examination and search burden is not required. In any event, there is an examination and search burden for these inventions as each requires a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries) and/or the prior art applicable to one invention would not likely be applicable to the other invention.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 6-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 1746

4. Claim 6 is considered an apparatus claim. Claim 6 requires “for implementing the method of claim 1”. Claim 1 is a method claim, and as each of claims 1 and 6 are directed to different statutory classes of invention claim 6 should not depend from claim 1. It is suggested to delete “for implementing the method of claim 1” and insert therein - - for sealing members made of plastic-coated paper or board”.

5. Claim 6 requires “clamps(8)”. Claim 8 requires “the clamp has jaws(8)”. It is not clear if multiple clamps are required or multiple jaws of a single clamp are required? From claim 8 it appears the apparatus comprises a clamp with multiple jaws. It is suggested to delete from claim 6 “clamps(8)” and insert therein - - a clamp - -. This is the interpretation given the claims.

6. Claim 6 recites the limitation "the seal point" in line 5. There is insufficient antecedent basis for this limitation in the claim.

7. Claim 6 recites the limitation "the salable members apart" in line 5. There is insufficient antecedent basis for this limitation in the claim.

8. Claim 6 recites the limitation "the plastic coating" in line 7. There is insufficient antecedent basis for this limitation in the claim.

9. Claim 6 requires “a laser beam (10) for directing a laser beam (11)”. Claim 7 requires the same. It is not clear what is required by a laser beam for directing a laser beam. The claim is interpreted as a laser for directing a laser beam.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 1746

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 6 and 8(6) are rejected under 35 U.S.C. 103(a) as being unpatentable over Bachhofer et al. (U.S. Patent 6,060,681) in view of Fukahori (JP 06-182571 and see also the abstract and machine translation).

Bachhofer discloses an apparatus comprising a clamp (9) having jaws (10) capable of retaining two sealable paper or board members in position located with respect to each other and a sealing line, a means (13 or 14) capable of pressing the members apart and opening a seal point, and a laser sealing means capable of moving along the sealing line including a laser (not shown) for directing a laser beam (7) capable of melting a plastic coating at the opened seal point. Bachhofer is silent as to a seal closing means. However, it was known in a substantially similar apparatus that following the laser sealing means a seal closing means (17) is included for the capability of pressing the members against each other and concealing the weld as shown by Fukahori (See the abstract and Figure 5). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include in the apparatus taught by Bachhofer a seal

Art Unit: 1746

closing means as suggested by Fukahori to provide the capability of pressing the members against each other to conceal the weld.

It is noted “Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim.” and “A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim.” (MPEP 2114 and 2115). The apparatus taught by Bachhofer as modified by Fukahori includes all of the structure claimed as set forth above and is capable of performing the intended use recited in each of the claims including on plastic-coated paper or board members.

It is noted “means (9) for opening the seal point” is considered to invoke 35 USC 112 sixth paragraph wherein the means (13 or 14) taught by Bachhofer for opening the seal point is considered an equivalent of the means-plus-function claimed as the means performs the function specified in the claim and is not excluded by any explicit definition provided in applicants specification.

Allowable Subject Matter

13. Claims 7 and 8(7) would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

14. The following is a statement of reasons for the indication of allowable subject matter:

Art Unit: 1746

The prior art of record fails to teach or suggest an apparatus as claimed including that the means for opening the seal point comprises two successive wedge-shaped elements pushing in between the paper or board members along the sealing line and that the laser directs the laser beam to the seal point between these elements.

Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **John L. Goff** whose telephone number is **(571)272-1216**. The examiner can normally be reached on M-F (7:30 AM - 4:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Katarzyna Wyrozebski can be reached on (571) 272-1127. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John L. Goff/
Primary Examiner, Art Unit 1746